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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,716	11/29/2005	Arnaud Bourge	FR 030058	7073

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER

THOMPSON, JAMES A

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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05/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/558,716	Applicant(s) BOURGE ET AL.	
	Examiner James A. Thompson	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The present application includes an International Search Report from WIPO which includes documents material to the patentability of the present application. Accordingly, Examiner respectfully suggests Applicant include the references cited therein in an Information Disclosure Statement (PTO-1449). See MPEP § 2001 with respect to the duty to disclose.

Specification

2. The abstract of the disclosure is objected to because the abstract as filed is simply two pages taken from a WIPO publication, rather than a properly filed abstract. See MPEP § 608.01(b) for the requirements of a proper abstract.

Appropriate correction is required.

3. Applicant is advised to scrutinize the presently filed specification to ascertain if there are any spelling and/or grammatical errors.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Firstly, Examiner assumes for the sake of claim analysis that Applicant intended to recite “the decoding method of claim 1” rather than “said decoding method” on line 2. There is no structure recited for the video decoding device of claim 2. The video decoding device recited in claim 2 could therefore encompass any structure that achieves the execution of the method of claim 1. This would include the structures known to Applicant and disclosed in Applicant’s disclosure, as well as those unknown to Applicant. The device structures unknown to Applicant could even include structures which are not currently possible with existing technology. Thus, for the reasons set forth above, claim 2 is not enabled by Applicant's disclosure.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 includes various colloquial language such as “on the one hand”, “on the other hand”, “up to the last one”, and so on. Thus, claim 1 does not particularly point out and distinctly claim the subject matter of the invention.

Further, claim 1 recites a series of steps, then recites in line 11 "said decoding method being characterized in that it comprises:", and then recites a continuing series of steps. Are the steps listed before the language "said decoding method being characterized in that it comprises:" to be considered a part of the claimed method? By placing the language "said decoding method being characterized in that it comprises:" after the first three recited steps of the method, Applicant has created ambiguity as to which steps actually comprise the invented method.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said decoding method" in line 1. There is insufficient antecedent basis for this limitation in the claim. Further, even assuming Applicant meant to recite "the decoding method of claim 1", there is no structure defined for the device recited in claim 2. Thus, claim 2 is not particularly defined so that one of ordinary skill in the art would not know how to make and/or use the device of claim 2.

Allowable Subject Matter

9. Examiner has not discovered in the prior art the subject matter recited in claims 1 or 2, either in a single reference or in an obvious combination of references. However, due to the ambiguity of the language of claim 1 and both the ambiguity and lack of enablement of claim 2, Examiner cannot presently determine with certainty if either of claims 1 or 2 would be allowable if the issues above with respect to 35 U.S.C. § 112 were rectified.

Conclusion

10. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Jung C. Ye, US-2008/0123740, Published 29 May 2008, US Priority Date of 23 September 2003. While not prior art, Ye is similar to claim 1 and shows the general state of the art.
- b. Bourge et al., US-2005/0232353, Published 20 October 2005, US Priority Date of 18 June 2003, co-pending application with same assignee.
- c. Xu et al., US-2005/0094731, Published 05 May 2005, Filed 09 November 2004, Continuation of application filed 21 June 2000.
- d. Carrasco et al., US-2005/0031037, Published 10 February 2005, US Priority Date of 20 June 2002, co-pending application with same assignee.
- e. Bourge et al., US-2005/0018771, Published 27 January 2005, US Priority Date of 20 January 2003, co-pending application with same assignee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is (571)272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A Thompson/
Primary Examiner, Art Unit 2625

19 May 2010